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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,433	07/14/2000	Shoji Yasuda	2870-0137P	5348

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Birch Stewart Kolasch & Birch LLP
P O Box 747
Falls Church, VA 22040-0747

EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,433

Applicant(s)

YASUDA, SHOJI

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "non-photosensitive fatty silver salt grains" in claim 1, line 3; claim 3, lines 2-3; claim 4, lines 3; claim 5, line 3; line 8, lines, line 2-3 is indefinite. Note to the term "fatty silver salt". The term "non-photosensitive fatty acid silver salt" should be used.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 7-9 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0887701 (EP'701).

A thermally processed image forming material containing a fatty acid silver salt has been known in EP'701. Note especially to page 2, lines 49-52; page 3, line 19-36; page 4, lines 35 to page 5, line 2; page 10, lines 43-45; page 12, line 19- 27; page 16, lines 35-49; page 20, lines 42-46; Tables 1-2 pages 27-29, Table 3, page 30-31. The organic silver dispersion was made from behenic acid and stearic acid. The material of EP'701 and that of the present claimed invention contains same fatty acid made with similar process. Accordingly, the invention as claimed lacks novelty. Alternatively, it would have been prima facie obvious to the worker of ordinary skill in the art to use a known process of forming fatty acid silver to provide an invention as claimed. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP'701 as applied to claims 1, 3, 7-8 above, and further in view of WO97/34196 (WO'196) and EP'433.

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The nucleating agent in claim 10 has been known in EP'433 on pages 6-13 and WO'196 on page 5. It would have been obvious to the worker of ordinary skill in the art to improve the image contrast of the material of EP'701 by incorporated therein the nucleating agent taught in WO'196 or EP'433 to provide the invention as claimed.

7. Claims 4, 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either EP'021433 (EP'433) or WO 97/341196 (WO'196).

The WO'196 on page 37, claim 1 and EP'433 on page 42, claim 1 disclose a material having composition similar to that of the claimed invention. The material contains a silver salt of aliphatic carboxylic silver salt, a reducing agent and a nucleating agent having formula claimed in the present claimed invention. Note to WO'196 on page 33 formulation A wherein the material contains isoxazole co-developer and silver behenate; and EP'433 on pages 34-36, Example 2 wherein the organic silver salt made from silver salt made from aliphatic carboxylic acid, and nucleating agent of the claimed invention. The EP'433 and WO'196 may not disclose the process of making the silver salt of aliphatic carboxylic acid at an operation pressure of $1,800 \text{ kg/cm}^2$ presented in the claimed invention, but this limitation is related to the process of preparing silver salt of aliphatic carboxylic acid which fails to differentiate between the claimed material and that of the prior art of record. "(E) Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior

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art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). Accordingly, the claimed material is either anticipated or would have been found obvious to the worker of ordinary skill in the art in the absence of showing otherwise.

Response to Arguments

On page 11, last paragraph of the Appeal brief filed on November 12, 2002, the applicant argue that "the invention of claim 1 is drawn to a thermally process forming material containing, in part, a non-photosensitive fatty silver salt grains prepared in a closed mixing means. Applicant has shown that a thermally processed image forming material of the present claimed invention possesses different properties from the prior art material. As such the present invention has been shown to possess superior properties over the prior art. As such, the invention has been shown to be non-obvious over the prior art".

The Examiner's position with respect to the rejection set forth above remained unchanged. The scope of claims 1, 5 are direct to the material containing reducing agent, binder and non-photosensitive fatty acid silver salt grains made by a closed mixing mean. The nucleating aid and photosensitive silver halide are not required therein. The scope of claim 4 directed to the use of nucleating aid such as such as an alkene derivative, isoxazole derivative or acetal derivative in combination with reducing agent, binder and non-photosensitive fatty acid silver salt grains made by closed mixing means.

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The Declaration under 37 CFR 1.132 filed on September 11, 2002 shows the preparation of organic silver salt dispersion A according to the process of EP'701 on page 20, lines 40-55 and the organic silver salt dispersion A' using the mixing mean, the process of the claimed invention. Both organic silver salt dispersion is incorporated in the photothermographic material prepared in a same manner set forth in the Example 1 of the present application. Therefore, the photothermographic material of the EP'701 has not been used as the base for the comparison to determine whether the claimed material is patentably distinct over that of EP'701 or has an improved property, which would have been found in the worker of ordinary skill in the art.

The applicants' position appears to be that the non-photosensitive fatty acid silver salt made by the claimed process would show an unexpected improvement of the photothermographic material regardless of the additives associated therewith. However, the Declaration fails to show such results.

The samples shown in the Declaration samples 19-23 is directed to the comparison of dispersion containing the non-photosensitive fatty acid silver salts grains made by EP'701 process and the non-photosensitive fatty acid silver salt grains by the inventive process using the photothermographic material of the applicants' preferred embodiment, while the scope of the claimed invention encompasses the additives using the photothermographic material of the embodiment preferred in the EP'701. Note for instance the material of Example 1 shown on pages 20-31 disclosed in EP'701 wherein the photothermographic material does not depend only the organic silver salts alone but with the other additive and the other parameter associated therewith. On

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page 29, it shown the results associated with the process of forming of the photothermographic material. On page 30-31 Table 1, it is shown that the photothermographic material made by the process of EP'701 show high coating surface quality. Therefore, it is improper to conclude that the claimed material having unexpected superiority over that of the EP'701 due to the failure of comparing the claimed material to the material of the prior art.

The invention of claims 4, 6 are rejected over either EP'021433 (EP'433) or WO 97/341196 (WO'196), but the applicants has not shown that the material of the claimed invention differs from that of EP'433 or W'196, or the material of the claimed invention has superior properties over that of the EP'433 or WO'196. The Declaration under 37 CFR 1.132 as filed shows the use of the nucleating aid therein, but it is irrelevant to the material of the EP'433 and WO'196. The Declaration fails to compared the claimed photothermographic material with that of the EP'433 and WO'196 wherein the nucleating aid taught therein.

The results presented on page 9 of the Appeal Brief and in the Declaration, samples 18-23 has been considered. The samples 18 and 21 are considered as commensurated with the scope of claims 1 and 5 since the nucleating aid is not required therein. The values of Dmin and Dmax of sample 21 are found to be improved in comparison with that of the comparative sample 18. However, the Declaration fails to state whether this improvement is significant which would have been found unexpected to the worker of ordinary skill in the art. "One way for the applicant to rebut a prima facie case of obviousness is to make a showing of "unexpected results",

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i.e., to show that the subject matter defined by the claims exhibits some superior property or advantage that a person of ordinary skill in the art would have been found surprising or "unexpected." As stated in the majority opinion of *In re Soni*, 54 F. 3d 746, 750, 34 USPQ 1684, 1687 (Fed. Cir. 1995). The samples 19-20 and 22-23 is not commensurate with the scope of the claimed invention since the nucleating agent is not required in the claims, i.e. EP'701. The samples 1-17 are irrelevant to the teaching of the prior art of record such as EP'433 or WO'496, and therefore, they cannot be used to differentiate the claimed material from prior art of record or to determine the unexpected results of the claimed material over the prior art of record. Moreover, the Declaration under 37 CFR 1.132 is insufficient to overcome the rejection under 35 USC 102(a) or 102(b) set forth above since the material stated in the Declaration is not the material of the applied prior art, but the material of the applicant's preferred embodiment. The applicant fails to show that the material taught in the applied prior art of record has different property when the applicant's non-photosensitive fatty acid silver salt made by the closed mixing means is used in lieu of that taught in the applied prior art of record. Accordingly, it is still believed that the rejection is still proper and should be maintained.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
January 21, 2003


Thorl Chea
Primary Examiner
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